APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,943	03/08/2000	ANDREW E FANO	AND1P525	1143 ·

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EXAMINER
VAN DOREN, BETH

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/520,943	Applicant(s) FANO ET AL.
	Examiner Beth Van Doren	Art Unit 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *08 March 2000* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *7* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   The following is a non-final, first office action on the merits. Claims 1-20 are pending.

Specification

2.   The use of trademarks such as HONDA®, BMW®, QUICKEN®, etc. has been noted in

this application. Trademarks should be capitalized wherever they appear and be accompanied by

the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary

nature of the marks should be respected and every effort made to prevent their use in any manner

which might adversely affect their validity as trademarks.

Appropriate correction is required in these instances and other instances in the

specification where the use of trademarks occurs.

Drawings

3.   The drawings are objected to under 37 CFR 1.83(a) because they fail to show the

elements described in the specification. In reference to figure 1 and figure 2a, figure 1 and figure

2a disclose the same elements. On page 9 of the specification, two different brief descriptions of

figures 1 and 2a are provided. However, it is unclear how the same figure would accomplish two

distinctly different tasks. Furthermore, page 25, lines 6-13, describes elements that are not

presented by figure 2a.

Any structural detail that is essential for a proper understanding of the disclosed

invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction

or corrected drawings are required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19 and 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a system comprising "logic". Looking to the specification, there is no disclosure as to any specific physical component that makes up the recited "logic" (i.e., hardware logic constructs) for performing the recited steps. Furthermore, claims 10 12 separately recite the software logic (i.e., computer program code) for performing the recited steps. Construed in light of these factors, the "logic" recited in claims 19 and 20 is neither concrete nor tangible since it is referring to mere mental constructs (i.e. logical flow). Consequently, it is respectfully submitted that the invention as recited in claims 19 and 20 is non-statutory subject matter.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.   Claims 19 and 20 recite a "system". However, this "system" is comprised of intangible, non-concrete "logic" (i.e., mere rational thoughts) as discussed above in the §101 rejection. A "system" is considered to be equivalent to a "machine" as defined in §101, requiring physical

components interconnected to function as a whole. As recited, claims 19 and 20 recite a

"system" that is compromised of mere logic. It is vague and indefinite as to how a collection of

mere logic (i.e. rationale thoughts) constitutes a "system" as defined by §101.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8.   Claims 1-4, 6-8, 10-13, and 15-20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Jones et al. (U.S. 6,021,397).

9.   As per claim 1, Jones et al. teaches a method for balancing attainment of goals,

comprising the steps of:

        (a)   presenting a plurality of goals (See column 2, lines 48-64, column 3, lines 40-67,

column 4, lines 10-34, column 5, lines 50-67, column 6, lines 3-40 and 50-58, column 7, lines

63-67, and column 8, lines 1-20, wherein the plurality of goals in the portfolio of goals are

presented to the user. These goals include savings goals, retirement goals, financial plans

(buying a house, sending a child to school), etc.);

(b)   adjusting preferences related to one of the goals (See column 2, lines 48-64,

column 3, lines 40-67, column 5, lines 50-67, column 6, lines 3-40 and 50-58, column 7, lines

63-67, and column 8, lines 1-20, wherein the user can iteratively adjust preferences related to the

goals, such as the savings rate, ages of retirement, quality of retirement, etc. The goal is the item

and the preferences its settings);

(c)   determining an impact on attaining the goals based on the adjusted preferences

(See column 2, lines 48-64, column 3, lines 40-67, column 5, lines 50-67, column 6, lines 3-40

and 50-58, column 7, lines 63-67, and column 8, lines 1-20, wherein the system analyzes the

effects of the changes on the other goals and preferences in the portfolio); and

(d)   displaying the impact on attaining the goals (See at least column 2, lines 48-64,

column 3, lines 40-67, column 5, lines 50-67, column 6, lines 3-40 and 50-58, column 7, lines

63-67, and column 8, lines 1-20, wherein the user can see the effects of the iterative changes).

10.   As per claim 2, Jones et al. discloses a method further comprising the step of receiving

information about a user, and wherein the goals are based on the received information (See

column 5, lines 54-67, wherein personal information about the user is received and the goals are

based on the received information, for example the profile built by this received information

allows the goals to be identified and the preferences to be adjusted).

11.   As per claim 3, Jones et al. teaches a method wherein the goals include at least one of:

home, vehicle, monthly allowance and savings, planned furniture expenses, planned appliance

purchases, vacation, children's education, and retirement home (See column 4, lines 10-34, and

column 6, lines 13-40 and 50-58, wherein the goals include at least home, monthly allowances and savings, children's education, retirement, etc.).

12.   As per claim 4, Jones et al. discloses a method wherein the step of adjusting preferences includes adjusting a degree of favoritism between time and quality (See column 3, lines 40-67, column 4, lines 10-34, column 5, lines 50-67, column 6, lines 3-40 and 50-58, column 7, lines 63-67, and column 8, lines 1-20, wherein the user adjusts preferences that includes adjusting an amount of want for time and quality. For example, with regards to retirement, the system plays with preferences including savings rate, retirement age, and retirement standard of living. The user can choose the age and quality of retirement while looking at other factors).

13.   As per claim 6, Jones et al. teaches a method wherein the step of adjusting preferences includes adjusting a time expectation for the amount of time expected for achieving the selected goal (See column 3, lines 40-67, column 4, lines 10-34, column 5, lines 50-67, column 6, lines 3-40 and 50-58, column 7, lines 63-67, and column 8, lines 1-20, wherein the preferences are adjusted and these preferences includes a time expectation for the anticipated amount of time in achieving a goal. For example, with retirement, the user can adjust and see effects on the age at which he/she can retire).

14.   As per claim 7, Jones et al. discloses a method wherein the step of adjusting preferences includes adjusting a quality expectation for the degree of quality expected for the selected goal (See column 3, lines 40-67, column 4, lines 10-34, column 5, lines 50-67, column 6, lines 3-40 and 50-58, column 7, lines 63-67, and column 8, lines 1-20, wherein the preferences are adjusted and these preferences include a quality expectation for the anticipated quality in the achievement

of the goal. For example, with retirement, the user can adjust and see effects on the standard of living at the point at which he/she retires).

15.   As per claim 8, Jones et al. teaches a method wherein the step of displaying the impact on attaining the goals includes displaying a summary of changes in achieving the goals as a result of the adjusted preferences (See column 6, lines 3-34, wherein the portfolio of the preferences is displayed to the user, and in an iterative process the user changes these preferences and sees the impact through a graphic display summarizing the portfolio as well as a summary of statistics relating to it).

16.   As per claims 10-13 and 15-17, claims 10-13 and 15-17 are article of manufacture versions of claims 1-4 and 6-8, respectively. Since the specification provides nothing more than projected general computer program code embodied on a general purpose computer readable medium, claims 10-13 and 15-17 are rejected on the same grounds as the method of claims 1-4 and 6-8, respectively.

17.   As per claims 19 and 20, claims 19 and 20 are system versions of claims 1 and 3. Since the specification provides nothing more than a system that is a network-implemented method, claims 19 and 20 are rejected on the same grounds as the method of claims 1 and 3.

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19.   Claims 5, 9, 14, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Jones

et al. (U.S. 6,021,397).

20.   As per claim 5, Jones et al. teaches a method wherein the step of adjusting preferences

includes adjusting to achieve certain goals in the portfolio (See column 3, lines 40-67, column 4,

lines 10-34, column 5, lines 50-67, column 6, lines 3-40 and 50-58, column 7, lines 63-67, and

column 8, lines 1-20, wherein the user adjusts the preferences for the goals with a certain specific

end result being the focus, such as a retirement age or a savings account amount). Jones et al.

further teaches the system monitoring one or more financial goals for the user (See column 6,

lines 35-59). However, Jones et al. does not expressly disclose adjusting a priority for the

selected goal.

    Jones et al. teaches a system wherein the user has a portfolio of goals and adjusts

preferences related to these goals to see the trade-offs in achieving a desired end result.

Furthermore, Jones et al. teaches setting up alerts for specific financial goals in the portfolio. It

is old and well known that when performing an iterative tradeoff analysis a person must have

specific end results in mind and priorities about the importance of each end result in order for the

process to eventually end. Therefore, it would have been obvious to one of ordinary skill in the

art at the time of the invention to have the user adjust priorities for selected goals in order to

increase the accuracy of the system's suggestions and analysis with regards to the user's

financial goals.

21.   As per claim 9, Jones et al. discloses a method further comprising the step of the user

providing an initial profile with the information the user chooses to provide, the profile

information being stored (See column 5, lines 50-67, and column 6, lines 1-20, wherein the user

may provide information he or she chooses and this profile works as the initial profile of the user); and

wherein the goals are based on the initial profile (See column 5, lines 50-67, and column 6, lines 1-20, wherein the initial assessment of the goals are based on the initial profile);

However, Jones et al. does not expressly disclose selecting a default profile, wherein the goals are based on the default profile.

Jones et al. discloses a system wherein the user chooses what information to initial include in a profile and then adjusts this initially chosen profile to reflect the appropriate goals of the user, as stated in column 5, lines 50-67, and column 6, lines 1-20. Default profiles are well known in the art. Therefore, it would have been obvious to allow the user to select a default profile as the initial profile of Jones et al. in order to increase the speed of the setup process by setting the initial profile for the user. The user of Jones et al. is able to alter the settings of the profile in an iterative process, therefore the initial settings are flexible.

22.   As per claims 14 and 18, claims 14 and 18 are article of manufacture versions of claims 5 and 9, respectively. Since the specification provides nothing more than projected general computer program code embodied on a general purpose computer readable medium, claims 14 and 18 are rejected on the same grounds as the method of claims 5 and 9, respectively.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maggioncalda et al. (U.S. 5,918,217) discloses determining a user profile based on user

preferences and personal information about said user that will allow said user to reach a financial

long-term goal.

Ferguson et al. (U.S. 6,064,984) discloses a financial planning tool that includes a

graphical display and shows the user's financial goals.

Williams et al. (U.S. 5,999,918) discloses a planning tool with a display that allows the

user to set their preferences in achieving a result.

Corlett et al. (U.S. 6,253,192) teaches a financial planning model for a user which

includes planning for future events like retirement.

Epstein ("Converging Future") discloses Personal Choice Point, which is a financial

planning tool of Accenture, and the Shopper's Eye, which is an Accenture tool that incorporates

a buyers preferences.

Fano ("Shopper's Eye") teaches a tool that brings relevant information to the user basaed

on his/her goals and preferences.

Booker ("A Think-Tank Vision") discusses the e-commerce tool "Shopper's Eye"'s

impact on the sale of furniture, clothing, etc.

Bellone ("Forecast your clients' financial future") discusses collecting a user's attributes

and preferences and creating a profile. This profile is used to attain a goal of the user. Attributes

include where the user lives and their income.

Waldron ("The game of Life") discloses client preferences and calculating these

preferences impact on the attainment of the client's goals.

Carey ("Putting the brains in your PC") teaches software that allows for the creation of

portfolios. Using the assets and information concerning a client, the software creates views

about said client's life that show ways to achieve said goals.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882.

The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 305-7687 for regular

communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-1113.

Bvd
bvd
March 4, 2003

TARIQ R. HAFIZ
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